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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,645	02/20/2004	Takahiro Goto	Q79923	2125
23373	7590	10/30/2006		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,645

Applicant(s)

GOTO, TAKAHIRO

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 4-6 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed August 17, 2006 has been entered and fully considered.
2. Claims 4-6, 10-17 and 18 are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6, 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAMURA et al. (EP 1 223 196 A2) in view of OSHIMA (JP 2002-040652).

a. NAKAMURA et al. teach a negative image-recording material, used to make a printing plate, wherein the negative image-recording material comprises a cyanine IR absorbent, a radical generator, a radically polymerizable compound and polymer binder (abstract; [0088]-[0096], claims 1 and 29). The IR absorbents of formula (3), (3-1), IR-1, IR-2, and IR-5 meet the present limitations for the presently claimed infrared absorbing compound. A sulfonium salt is among the preferred radical generators and is represented by general formula (V) (claims 15-20; [0066]-[0069]). In general formula (V), R31, R32 and R33 are optionally substituted hydrocarbon groups having at most 20 carbon atoms. Examples of substituents include halogen atoms.

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Nakamura et al. do not exemplify a sulfonium salt having three aryl groups two of which are substituted specifically with chlorine atoms however it would have been obvious to one of ordinary skill in the art to incorporate any halogen substituent including chlorine atoms. Other preferred radical generators include iodonium salts and diazonium salts, which can be used alone or in combination of two or more (claims 15-20; [0066]-[0072]). Linear organic polymers, soluble or swellable in water or weakly alkaline water, are preferred as the binder polymer ([0088]). NAKAMURA et al. does not teach the binder polymer required in the present application. However, based on the teachings of OSHIMA it would have been obvious to one of ordinary skill in the art to use the binder polymer having a repeating unit of formula (I) wherein  $R^2$  represents a linking group having 3 to 30 carbon atoms in order to obtain sufficient print durability and high productivity (abstract; [0005]-[0009]). According to NAKAMURA et al., especially preferred supports of the image forming material are aluminum supports having a center line average roughness between 0.1 and 1.2  $\mu\text{m}$  ([0116]-[0127]).

### ***Response to Arguments***

5. Applicant's statement of common ownership is in accordance with the provisions of 35 USC 102(c) and is therefore sufficient to overcome the rejection under 35 USC 103(a) over NAKAMURA et al. in view of SUGASAKI. Accordingly, the rejection is withdrawn. However, upon further consideration, a new ground of rejection is made in view of NAKAMURA et al. (EP 1 223 196 A2) and OSHIMA (JP 2002-040652).

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara L. Gilliam*

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
October 29, 2006